REMARKS/ARGUMENTS

Drawings

The Examiner has previously accepted the drawings, and Applicant appreciates the same.

Claim Amendments

The Applicant has made certain claim amendments as noted above. For instance, the Applicant has amended claim 1 to strikeout or delete the following phrase from the claim:

> ~~such that a user of the radio apparatus may not readily change that the radio signal receiver is limited to receiving a the one predetermined radio signal frequency~~

and has indicated that the radio signal receiver "is" limited. The Applicant submits, and those of ordinary skill in the art will recognize, that the phrases "is limited" and "thereby limiting the audio output" would inherently include that the user may not readily change that the radio can play the single radio station, and/or that the user cannot change the radio station.

Claim 1 has been further amended to additionally include the following:

> further wherein the radio apparatus includes a promotional identifier of one of broadcast services and a non-broadcast advertiser.

It will be appreciated by those of ordinary skill in the art that this would include any kind of promotional identifier whether imprinted on the outer encasement or other part of the radio apparatus, or attached to the radio apparatus, or partially or wholly defined by the outer encasement.

Claim Rejections – 35 USC § 103

The Examiner has rejected claims 1-53 as being obvious, primarily over Smith Jr. '607, in view of Scrivens '518. The Applicant respectfully requests that the Examiner reconsider the rejections based on the arguments and points submitted below, and where applicable, based on the amendments to the claims submitted above.

The Applicant's additional arguments and reasons why the Examiner has not met his burden to set forth a *prima facie* case for obviousness, can generally be summarized as follows:

1. Smith '607 is a receiver controller for car radios and television receivers which is programmed to initially receive a pre-determined signal, and then the radio or television may easily be changed by the user to receive the signals from other radio or television stations. Even the initial pre-determined setting can be easily over-ridden by the user of the car, radio or television – by merely touching one of the normal buttons a user may touch when initially adjusting the radio (such as the tune up, tune down or one of the preset station buttons or keys. (Col 5, line 66 through Col 6 line 5). Two examples given in Smith are using the

car radio in a rental car that automatically tunes itself to an airport station to give instructions to inform the driver/user directions to exit the airport, or other information. The same basic example is given for televisions in hotels, programming the controller to receive the signals from one particular station for a short initial period of time, and then to allow the user to change the channel to receive signals from other sources or stations. Again however, the initial setting can be over-ridden by the user.

2. **The Smith '607 reference combined with Scrivens '518 DO NOT contain all the elements of this invention as claimed**, such as the limitation in claim 1 for example, that "a user of the radio apparatus may not readily change that the radio signal receiver is limited to receiving a predetermined radio signal frequency".

Smith actually teaches away from this invention and is at best merely a temporary initial signal instead of a dedicated apparatus in which the user cannot readily change the signal. Due to the different nature of the Smith device, the user of the receiver control of Smith '607 may also readily change or override the initial, temporary signal being received (Smith '607 at Col 5 line 66 – Col 6 line 5):

> During the predetermined time of tuning to the power-on signal source, **a user preferably may override (27) the automatically tuned signal source to receive a user's selected source such as by selecting a tune up, tune down or other radio button preset key**.

This cancels the power-on sequence, following which normal receiver operation would occur (24). [Emphasis added]

The ability of the user of the Smith device being able to readily change the radio station, to easily and readily over-ride the initial setting, is directly opposite from this invention and would negate one of the purposes of some embodiments of this invention.

3. There is nothing in the Smith '607 or in the Scrivens '518 patent reference which teaches or suggests that it can or should be combined with the other. There is further nothing in either which shows a motivation to make the combination of Smith '607 and SCrivens '518.

4. The Scrivens '518 reference is directed to a fixed frequency, single frequency receiver, and not one which wherein a multi-frequency radio signal receiver is secured relative to the outer encasement, the radio signal receiver being capable of receiving a plurality of frequencies of radio signals.

5. The combination of references does not include all the elements of the claims in question as stated above in paragraph numbered 2, and further because there being no promotions or advertisements in the encasements or defined by the encasements in Smith or Scrivens.

6. The proposed modification or combination of Smith with Scrivens changes the principle of operation of the Smith device and of Scrivens device, for the reasons stated above, and therefore the teachings of the references are not sufficient to render the

claims prima facie obvious. The Smith device is directed to a multi-frequency receiver which is intended to be used by the user to select signals to be received, even though it may be programmed to be initially directed to an initial single input signal.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

7. The proposed modification or combination of Smith '609 with Scrivens changes the principle of operation of the Smith reference (for the reasons stated above), and therefore the teachings of the references are not sufficient to render the claims prima facie obvious. Taking a programmable car radio with a controller (or television), dedicated for use to access any one of a number of different signals or stations, and completely cutting off the ability of users to change the channel or signal received,

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The arguments above apply to each of the independent claims, and therefore to the claims upon which they depend, and therefore the Applicant asserts that all the claims are in a position for allowance.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee, 61 U.S.P.Q. 2d 1430,* decided January 18, 2002, the Federal Circuit held:

> ... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

> The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. <u>If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-</u>

> obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

> Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Prior Art Made of Record and Not Relied Upon

The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

Conclusion

Applicant therefore submits Claims 1-53 are in a position to proceed to allowance.

Respectfully submitted,

Dated: 9-19-05 By: _____

Mark W. Hendricksen
Reg. No. 32,356

Attachments: There are none.